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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,362

10/14/2003

Joseph A. Zupanick

067083.0283

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09/28/2005

FISH & RICHARDSON P.C.  
1717 MAIN STREET  
SUITE 5000  
DALLAS, TX 75201

EXAMINER

STEPHENSON, DANIEL P

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/687,362

**Applicant(s)**

ZUPANICK, JOSEPH A.

**Examiner**

Daniel P. Stephenson

**Art Unit**

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20 and 23 is/are allowed.
- 6) ☐ Claim(s) 1-4, 8-10, 14-17, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 5-7 and 11-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 8/9/05, 9/13/05.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 9, 10, 15, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Russ. Russ discloses a method for removing particulate laden fluid in which a downhole device is positioned. The device contains a pump (22) and an agitator (28). The agitator agitates the fluid as it is being pumped out of the downhole cavity. The downhole device is put through a wellbore into a subsurface cavity, where the transverse dimension of the cavity is greater than the wellbore. The agitator is made of a plurality of arms that are outwardly extendable. The pump and inlet are indirectly coupled with the agitator.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 9 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillger in view of Russ. Hillger discloses a method for removing particulate laden fluid from a water well in which a downhole device is positioned. The device contains a downhole pump (7) and an agitator (29). The agitator agitates the fluid as it is being pumped out of the downhole

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cavity. Hillger does not disclose that the subsurface cavity has a transverse dimension greater than the transverse dimension of the wellbore. Russ discloses a water well where the water-bearing portion of the well has a transverse dimension greater than the wellbore leading to the cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method and apparatus of Hillger with the wellbore and cavity of Russ. This would be done because Russ is disclosed as a water well and Hillger is disclosed as useful within a water well.

With regards to claim 16, it is Officially Noticed that it is notoriously conventional to use a variety of pumps in the wellbore art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a suction rod pump on the apparatus of Hillger in view of Russ. This would be done to allow for greater suction of fluid and for less contamination by particles.

It is noted that this is a reiteration of the Official Notice made in a previous action, and as such is now considered to be prior art.

5. Claims 1-4, 8-10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields in view of Russ. Fields discloses a method for removing particulate laden fluid from a water well in which a downhole device is positioned. The device contains a pump for the removal of fluid through an inlet (179) and an agitator (188). The agitator agitates the fluid as it is being pumped out of the downhole cavity. The agitator is comprised of a number of blunt arms that are expanded downhole inside the cavity. The arms are rotated about the longitudinal axis of the device. Fields does not disclose that the subsurface cavity has a transverse dimension greater than the transverse dimension of the wellbore. Russ discloses a water well where the

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water-bearing portion of the well has a transverse dimension greater than the wellbore leading to the cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method and apparatus of Fields with the wellbore and cavity of Russ. This would be done because Fields would be useful in the cleaning of the debris from the bottom of the well disclosed in Russ.

With regards to claims 16 and 17, it is Officially Noticed that it is notoriously conventional to use a variety of pumps in the wellbore art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a downhole pump or suction rod pump on the apparatus of Fields in view of Russ. This would be done provide a variety of pumping methods based on design of the wellbore.

***Allowable Subject Matter***

6. Claims 18-20 and 23 are allowed.

7. Claims 5-7 and 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stephenson whose telephone number is (571) 272-7035. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

DPS 